

Remarks

Terminal Disclaimer

Applicants notes with appreciation the acceptance of the terminal disclaimer regarding application 10/678,599.

Applicant respectfully traverses the rejection of claims 6 – 9, 12 – 13 and 29 under 35 U.S.C. §103(a) over Lam (EP 1203897) in view of Brassell (US 4772508) and in further view of Tradewell (4444574).

Claims 6 – 9, 12 – 13 and 29 patentably distinguish over the combinations of references in the recitation of the secondary layer comprising about 5% to about 35%, by weight, of partially carbonized carbon fibers, based on the weight of the fibrous base material, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Nowhere does Lam disclose or suggest that the secondary layer of the friction material comprises carbon fibers.

Lam teaches a friction material of carbon fibers. Lam does not teach a friction material of carbon fibers in the secondary layer. To substitute carbon fibers of any kind for the carbon particles of Lam does not meet the “common sense” test of telefax let alone the old” teaching, suggestion, motivation” test.

Earlier this year, the United States Supreme Court issued an unanimous decision in KSR v. Teleflex, 550 US , 127 S.Ct. 1727 (2007) concerning the

issue of obviousness as applied to patent claims. The Court clearly stated that the Federal Circuit's application of the "teaching, suggestion, motivation" test had been "too rigid." The Court held that a person of ordinary skill is also a person of ordinary creativity. The Court reasoned that a person of ordinary skill has "common sense" and could find motivation implicitly in the prior art. The court also held that the finding must be based facts with a reasoned rationale.

It remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

Assumptions about knowledge in the art cannot substitute for evidence thereof.

The Examiner states that Lam teaches carbon fibers (page 9, lines 10 – 13).

Applicants respectfully submit that Lam only teaches carbon fibers in the primary or base layer. Lam does not teach carbon fibers in the secondary layer. Further, Lam clearly distinguishes between carbon fibers and carbon particles. One is not a substitute for the other.

Clearly no reason exists for placing carbon fibers in the secondary or top layer.

Nowhere does Lam disclose or suggest that the secondary layer of the friction material comprises partially carbonized carbon fibers.

Nowhere does Lam disclose or suggest that the secondary layer of the

friction material comprises 5% to 35%, by weight, of partially carbonized carbon fibers.

Nowhere does Lam disclose or suggest that the secondary layer of the friction material comprises partially carbonized carbon fibers, wherein the partially carbonized carbon fibers are 65 to 90% carbonized.

Lam is deficient. Brassell and Tradewell do not supply those deficiencies. The rejection attempts to add to Lam what is not there.

The rejection fails to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed. See In re Kahn, 441 F.3d 977, 985-86, 78 U.S.P.Q. 1329, 1335 (Fed.Cir. 2006).

The rejection does not provide any evidentiary basis to support the findings. See In re Ahlert, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 420-21 (CCPA 1970).

Further, Brassell and Tradewell are non-analogous art.

Applicants invention relates to wet friction materials used in advanced transmission and braking systems. The friction materials must remain stable at high temperatures in high pressure application.

The filtering of Brassell and Tradewell have nothing to do with friction materials for advanced transmissions. See e.g. In re Zurko, 258 F.3d 1379, 1386 (Fed.Cir. 2001).

No basis in fact or theory exists for picking and choosing from Brassell and Tradewell as suggested.

Applicants respectfully submit that one cannot rely on hindsight in reaching an obvious determination. It is essential that the decision maker forget what he or she has been taught by the claimed invention. One cannot use piecemeal reconstruction to arrive at the claimed invention. See Golight v. Walmart, CAFC 02-1608, 2004. Also see In re Fine, 837 F.2d 1071 5 USPQ 1596 (CAFC 1988). The rejection ignores the express limitations in the claims. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. 796 F2d 443, 448-449, 240 USPQ 416, 420 (Fed. Cir. 1986).

The rejection clearly is based on conclusory assertions and assumptions not found in the prior art.

Accordingly, Applicant respectfully asks that the Examiner withdraw this rejection under 35 U.S.C. §103.

Applicant respectfully submits that claims 6 – 9, 12 – 13 and 29 are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,

EMCH, SCHAFFER, SCHAUB
& PORCELLO CO., L.P.A.

A handwritten signature in black ink, appearing to read 'P. Pacella', with a stylized flourish at the end.

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